

REMARKS

Status of the Claims

Claims 22-42 are pending in the application. In this Response, none of the claims have been amended or cancelled.

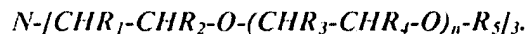
Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the following remarks.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 22-42 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Still et al.*, Tetrahedron Letters, 24(41):4405-4408 (1983) in view of *Heimann et al.*, Chem. Ber., Vol. 112, pp. 1392-1399 (1979). Initially, it should be noted that Heimann is a non-English document. It is not clear from the Office Action dated June 27, 2007, if the Examiner has relied on an English language equivalent of Heimann or an English language translation of Heimann in setting forth the rejection. The rejection is respectfully traversed.

The Office has the initial burden of establishing a *factual basis* to support the legal conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some *articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

It should be noted that independent claim 22 recites *a process for the diastereoselective preparation of olefins via the Homer-Wadsworth-Emmons reaction*, which includes, *inter alia*, reacting at low temperature a phosphonate with a carbonyl derivative in the presence of a base in a suitable solvent, wherein *a tris(polyoxaalkyl)amine sequestering reagent of formula (I)*:



is added to the reaction medium in an amount that is effective to increase the diastereoselectivity of the olefins.

In contrast, Still relates to the use of 18-crown-6 ether. (Pages 4405-4407). Still discloses that recent results with trimethylphosphonopropionate/KOtBu and saturated, alpha-branched aldehydes have shown that at least one class of trisubstituted unsaturated ester may be prepared with high Z selectivity by a Horner-Emmons reaction. However, as agreed by the Examiner, Still does not disclose or suggest use of a tris(polyoxaalkyl)amine as the sequestering agent. (Page 4, Office Action).

While Heimann allegedly discloses that tris(polyoxaalkyl)amine is used as a sequestering agent, Applicants respectfully submit that Heimann does not disclose or suggest the diastereoselective preparation of olefins via the Homer-Wadsworth-Emmons reaction.

Moreover, Applicants respectfully submit that there is no reason one of ordinary skill in the art would turn to Heimann after reading Still to obtain the presently recited claims. Still's 18-crown-6 ether is a compound having a cyclic structure, whereas TDA-1, which is an example of a tris(polyoxaalkyl)amine, is a three-armed ligand. Further, Applicants note that a goal of present disclosure was to replace 18-crown-6 because this crown ether has the drawback of being expensive, toxic, and harmful to the environment. (Page 1, lines 24-25). Moreover, a goal of the present disclosure was to find another means for improving the diastereoselectivity of the olefin obtained without using 18-crown-6 ether. (Page 1, lines 25-26). Applicants respectfully submit that the present disclosure unexpectedly shows that the use of a tris(polyoxaalkyl)amine makes it possible to improve the diastereoselectivity in the Homer-Wadsworth-Emmons reaction to levels comparable to those obtained with 18-crown-6. (See, for example, page 1, lines 28-30). See also Tables I and II on pages 9-10 of the present specification.

Applicants respectfully submit that a reference must be viewed as a whole for what it teaches. "[I]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965); see also *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 U.S.P.Q. 81, 93 (Fed. Cir. 1986).

The Examiner relies on the fact that the elements of the pending claims can supposedly be found in the combination of references as the basis for finding both the motivation and suggestion to combine them. The Federal Circuit has consistently held that "...the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the same manner claimed". *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner, however, has not pointed to specific support for the motivation to combine Still and Heimann. As such, Applicants respectfully submit that the standard enunciated by the Federal Circuit has clearly not been met.

Applicants respectfully submit that the Examiner has not set forth on the record the particular reasons a person of skill in the art, would have selected the combination of Still and Heimann. In particular, Applicants respectfully submit that the Examiner has not set forth on the record the particular reasons a person of skill in the art would replace Still's 18-crown-6 ether with Heimann's tris(polyoxaalkyl)amine when there are many sequestering agents known in the art.

It should be noted that M.P.E.P. § 2143.02 provides that the prior art cannot be modified or combined to reject claims as prima facie obvious unless there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants further respectfully submit that there is no reasonable expectation of success in combining Still and Heimann. According to Still's disclosure, 18-crown-6 is used to prepare Z-unsaturated esters. As such, there would be no reason for one of skill in the art to turn to Heimann and use Heimann's tris(polyoxaalkyl)amine in Still's preparation of esters using 18-crown-6 ether.

Again, the Office Action fails to set forth a combination "in the same manner claimed" as unequivocally enunciated by the Federal Circuit. The Federal Circuit has consistently held that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed". *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). The Examiner has failed to state on the record the specific support that teaches the presently pending claims would have been obvious to one skilled in the art.

As such, in light of at least the foregoing, Applicants respectfully submit that the obviousness rejection should be withdrawn.

Conclusion

In view of at least the foregoing remarks, reconsideration of the claims and allowance of the subject application is earnestly solicited. In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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